REMARKS

Claims 1, 5-23, 25-31, 33-34, 36-40 and 41-50 are pending in the present application. Claims 1, 5-23, 25-31, 33-34, 36-40 and 41-50 were rejected by the Examiner.

Based on the Amendments and following Remarks, Applicant respectfully requests that the Examiner reconsider all outstanding objections and rejections and they be withdrawn.

The Amendment

The Claim amendments are supported, for example, by page 2, lines 22-26; page 4, line 22 to page 5 line 2; page 5 line 28 to page 6 line 15; page 8, lines 3-30; and page 9 lines 11-24.

No new matter is added in the amendments. The Examiner is respectfully requested to enter the amendments.

The Response

35 USC § 112, Paragraph 2 Rejection

Claims 1-22, 34 and 36-38 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. This rejection is overcome in view of the amendments to the claims.

Claims 1, 6, 34 and 37 were amended to provide sufficient antecedent basis for the terms recited in the office action. Therefore, the rejection to Claims 1-22, 34, and 36-38 should be withdrawn.

35 U.S.C. § 102(e) Rejection

Claims 1, 5, 9, 10, 12, 14-20, 22, 23, 26-28, 31, 33, 34 and 36-38 were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Hendricks et al. (U.S. Pat. No. 6,463,585 B1).

Claims 5, 12, 14, and 26-27 are cancelled without prejudice. The remaining rejection to Claims 1, 9, 10, 15-20, 22, 23, 28, 31, 33, 34 and 36-38 is traversed in part and overcome in part in view of the amendments.

Applicant has amended Claims 1, 23, 31, 34 and 37 to clarify the invention as an Internet message delivery system, wherein a viewing station is operatively connected to a personal computer and processing system through the Internet. The method claims also incorporate the

use of a logging in procedure to identify a specific user, allowing the message delivered to be tailored to an individual user.

The Hendricks patent discloses a message system that sends targeted advertising to identified television terminals during pre-scheduled commercial breaks (see Abstract). The patent contemplates "feeder channels" which carry alternate advertising that is suited for certain viewer audiences depending on information received from the identified television terminal or subscriber household. Col. 4, lines 35-42. The television terminals store data regarding viewer habits, which is retrieved by a program controller through a polling cable-based system. Col. 3, lines 60-63. The information gathered from each television terminal is analyzed to determine what message, such as an advertisement, would be suitable. Col. 4, lines 15-17. The television terminal is then instructed to switch to one of the alternate viewing channels with the appropriate advertisement during one of the scheduled program breaks. Col. 4, lines 25-42.

Respectfully, the Hendricks patent does not teach the use of the Internet for delivery of a viewer's viewing behavior or demographic information to a processing server from a viewing station, nor does it teach the use of the Internet for delivery of a multimedia message tailored to an individual to the viewing station from a processing system. Instead, the Hendricks patent strongly discourages against the use of the Internet as a means for communicating between a processing server and viewing station because it cannot the enable the contemplated invention in Hendricks. For example, in discussing the methods for the network controller receiving information from the set top television terminals, the patent notes the preferred use of the polling mechanism mentioned above. Col. 65, lines 15-23. However, in speaking of a third method of using telephone modems and/or the Internet, the specification discloses the incompatibility of the Internet with the cable-based system because the third method "does not allow for upstream interactivity over the cable medium." Col. 65, lines 30-33.

Therefore, Hendricks specifically teaches that the use of an Internet-based communications system, versus a cable medium, cannot fully enable the invention because a network controller interacting with the television terminal through a telephone modem or the Internet to download viewing behavior information does not allow upstream interaction of the user with services offered by the cable medium, severely limiting the use of the system.

More importantly, any upstream interactivity of an individual user with the processing system or server of the instant application is completely absent and not contemplated in the Hendricks patent. The Hendricks patent deals with the collection of viewing behavior information from individual television terminals, not individual users. Therefore, the Hendricks patent cannot differentiate between individual users watching the television terminal, nor can it track if an individual is watching on a different television terminal. In contrast, the instant invention allows the differentiation of individuals, not just individual display terminals, and can also track an individual moving to a different display terminal, through the use of a log-on procedure. The log-on procedure prompts an individual user at the beginning of a viewing session to enter a unique identifier that identifies the individual, not just the display equipment being used as the Hendricks patent does. Because of these differences, the claims of the instant application do not read on the Hendricks patent.

Therefore, the 35 U.S.C. §102(e) rejection of Claims 1, 9, 10, 15-20, 22, 23, 28, 31, 33, 34 and 36-38 should be withdrawn.

35 U.S.C. § 103(a) Rejections

Claims 13, 21, 29, 30, 39, 40 and 42-48 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hendricks et al. (U.S. Pat. No. 6,463,585 B1). The rejection to Claims 13, 21, 29, 30, 39, 40 and 42-48 is traversed in part and overcome in part in view of the amendments.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations. MPEP § 2142.

1. **Claim 13 is rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Hendricks in view of Official Notice taken by the Examiner.**

Regarding Claim 13, the Examiner takes Official Notice and alleges that the art of video-on-demand service was well-known at the time of filing to one of ordinary skill in the art, and that combined with the teachings in Hendricks renders obvious the instant claim. Applicant has

amended independent Claim 1 to recite the elements of a log-on procedure, as well as the use of the Internet in the communication between the processing system and computer display means.

As amended, the present invention would not have been obvious over the combination of Hendricks and what the Examiner alleges was well-known at the time of filing because neither source, nor their inappropriate combination, teaches or suggests the use of the Internet to deliver sponsored video messages based on viewing behavior and demographic information of the viewer, in combination with the use of a video-on-demand system, into broadcasts selected by an individual viewer.

First, there is no motivation to make the combination suggested by the Examiner because the proposed combination of sources do not provide any teaching or suggestion to modify or combine the references as the Examiner has suggested.

In fact, the Hendricks patent teaches away from the instant application by discouraging the use of the Internet in combination with a processing system and a display means to collect viewing behavior information. The Hendricks specification explicitly discloses the incompatibility of the Internet with the cable-based system because the third method "does not allow for upstream interactivity over the cable medium." Col. 65, lines 30-33. Therefore, the Hendricks patent teaches away from the use of an Internet system for communication between the processing system and display means, and suggests that there is no reasonable expectation of success, either alone or in combination with the cited Official Notice.

Moreover, any upstream interactivity of an individual user with the processing system or server of the instant application is completely absent and not contemplated in the Hendricks patent. The Hendricks patent deals with the collection of viewing behavior information from individual television terminals, not individual users. Therefore, the Hendricks patent cannot differentiate between individual users watching the television terminal, nor can it track if an individual is watching on a different television terminal. In contrast, the instant invention allows the differentiation of individuals, not just individual display terminals, and can also track an individual moving to a different display terminal, through the use of a log-on procedure. The log-on procedure prompts an individual user at the beginning of a viewing session to enter a unique identifier that identifies the individual, not just the display equipment being used as the Hendricks patent does.

Adding the Official Notice of the Examiner alleging that a video-on-demand service was well known to those of ordinary skill in the art to Hendricks does not cure these deficiencies. Applicant respectfully points out to the Examiner that the Hendricks system does not incorporate the use of an individual identifier system, but rather identifies only a particular television terminal. On the contrary, it would not have been obvious to one of ordinary skill in the art to modify Hendricks by including a video-on-demand system because the Hendricks could not target an individual viewer. Therefore, even with the improper combination of the two sources, the combination does not teach or suggest all of the claim limitations in the present invention.

Reconsideration and withdrawal of the rejection is respectfully requested.

2. Claims 21, 29-30, 44 and 45-48 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Hendricks in view of Official Notice taken by the Examiner.

Regarding Claims 21, 29-30, 44 and 45-48 the Examiner takes Official Notice and alleges that pre-caching data was well-known at the time of filing to one of ordinary skill in the art, and that combined with the teachings in Hendricks renders obvious the instant claim. Applicant has amended independent Claims 1, 23 and 44 to recite the elements of a log-on procedure, as well as the use of the Internet in the communication between the processing system and computer display means.

As amended, the present invention would not have been obvious over the combination of Hendricks and what the Examiner alleges was well-known at the time of filing because neither source, nor their inappropriate combination, teaches or suggests the use of the Internet to deliver sponsored video messages based on viewing behavior and demographic information of the viewer into broadcasts selected by an individual viewer in combination with the use of pre-caching information when the multimedia content to be viewed is generally not available for presentation.

First, there is no motivation to make the combination suggested by the Examiner because the proposed combination of sources do not provide any teaching or suggestion to modify or combine the references as the Examiner has suggested.

In fact, the Hendricks patent teaches away from the instant application by discouraging the use of the Internet in combination with a processing system and a display means to collect viewing behavior information. The Hendricks specification explicitly discloses the incompatibility of the Internet with the cable-based system because the third method "does not allow for upstream interactivity over the cable medium." Col. 65, lines 30-33. Therefore, the Hendricks patent teaches away from the use of an Internet system for communication between the processing system and display means, and suggests that there is no reasonable expectation of success, either alone or in combination with the cited Official Notice.

Moreover, any upstream interactivity of an individual user with the processing system or server of the instant application is completely absent and not contemplated in the Hendricks patent. The Hendricks patent deals with the collection of viewing behavior information from individual television terminals, not individual users. Therefore, the Hendricks patent cannot differentiate between individual users watching the television terminal, nor can it track if an individual is watching on a different television terminal. In contrast, the instant invention allows the differentiation of individuals, not just individual display terminals, and can also track an individual moving to a different display terminal, through the use of a log-on procedure. The log-on procedure prompts an individual user at the beginning of a viewing session to enter a unique identifier that identifies the individual, not just the display equipment being used as the Hendricks patent does.

Adding the Official Notice of the Examiner alleging that pre-caching was well known to those of ordinary skill in the art to Hendricks does not cure these deficiencies. Applicant respectfully points out to the Examiner that the Hendricks system does not incorporate the use of an individual identifier system, but rather identifies only a particular television terminal. On the contrary, it would not have been obvious to one of ordinary skill in the art to modify Hendricks because the Hendricks patent could not target an individual viewer. Therefore, even with the improper combination of the two sources, the combination does not teach or suggest all of the claim limitations in the present invention.

Reconsideration and withdrawal of the rejection is respectfully requested.

3. Claims 39-40 and 42-43 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Hendricks in view of Official Notice taken by the Examiner.

Regarding Claims 39-40 and 42-43, the Examiner takes Official Notice and alleges that transmitting advertisement and video programming over the Internet to a viewing station was well-known at the time of filing to one of ordinary skill in the art, and that combined with the teachings in Hendricks renders obvious the instant claim. Applicant has amended independent Claim 39 to recite the limitation of an individual user logging on to a viewing station prior to the delivery of a sponsored message and selected multimedia content.

As amended, the present invention would not have been obvious over the combination of Hendricks and what the Examiner alleges was well-known at the time of filing because neither source, nor their inappropriate combination, teaches or suggests the use of the Internet to deliver sponsored video messages based on viewing behavior and demographic information of the viewer into broadcasts selected by an individual viewer, and to deliver selected multimedia content to a viewing station being used by an individual user.

First, there is no motivation to make the combination suggested by the Examiner because the proposed combination of sources do not provide any teaching or suggestion to modify or combine the references as the Examiner has suggested.

In fact, as the Examiner has stated, the Hendricks patent teaches away from the instant application by discouraging the use of the Internet in combination with a processing system and a display means to collect viewing behavior information. The Hendricks specification explicitly discloses the incompatibility of the Internet with the cable-based system because the third method "does not allow for upstream interactivity over the cable medium." Col. 65, lines 30-33. Therefore, the Hendricks patent teaches away from the use of an Internet system for communication between the processing system and display means, and suggests that there is no reasonable expectation of success, either alone or in combination with the cited Official Notice.

Moreover, any upstream interactivity of an individual user with the processing system or server of the instant application is completely absent and not contemplated in the Hendricks patent. The Hendricks patent deals with the collection of viewing behavior information from individual television terminals, not individual users. Therefore, the Hendricks patent cannot

differentiate between individual users watching the television terminal, nor can it track if an individual is watching on a different television terminal. In contrast, the instant invention allows the differentiation of individuals, not just individual display terminals, and can also track an individual moving to a different display terminal, through the use of a log-on procedure. The log-on procedure prompts an individual user at the beginning of a viewing session to enter a unique identifier that identifies the individual, not just the display equipment being used as the Hendricks patent does.

Adding the Official Notice of the Examiner alleging that delivering multimedia content to viewing stations via the Internet was well known to those of ordinary skill in the art to Hendricks does not cure these deficiencies. Applicant respectfully points out to the Examiner that the Hendricks system does not incorporate the use of an individual identifier system, but rather identifies only a particular television terminal. On the contrary, it would not have been obvious to one of ordinary skill in the art to modify Hendricks because the Hendricks patent could not target an individual viewer. Therefore, even with the improper combination of the two sources, the combination does not teach or suggest all of the claim limitations in the present invention.

Reconsideration and withdrawal of the rejection is respectfully requested.

CONCLUSION

Enclosed with this response is a petition for a one-month extension of time including authorization for the prescribed fee. If any other fees are due with this response, please charge the same to our Deposit Account **No. 08-3038**, referencing Docket No. 05742-0004-NPUS00.

Applicant believes that the application is in good and proper condition for allowance. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is encouraged to call the undersigned at (949) 759-3904.

Respectfully submitted,

Date: November 6, 2003

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